

REMARKS

This amendment is filed in connection with a Request for Continued Examination. Reconsideration of the application in light of the foregoing amendments and the following remarks is respectfully requested.

No claims are cancelled by the present amendment. New claims 37-43 are added. Thus, claims 1-43 are currently pending for consideration.

With regard to the prior art, the final Office Action of October 6, 2003 rejected claims 1-3, 7-13, 16-18, 20-22 and 24 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,574,495 to Caporizzo. (“Caporizzo”). All other examined claims were rejected under 35 U.S.C. § 103(a) as obvious in view of the teachings of Caporizzo, taken alone or in combination with a variety of other prior art references. For at least the following reasons, these rejections are respectfully traversed.

Claim 1 recites:

A method of locating set-top terminals within a cable television system and using location information for said terminals to improve efficient operation of said cable television system, the method comprising:

with a system controller, automatically determining which upstream plant of a plurality of upstream plants transmits a first message to said system controller from a particular set-top terminal that has not communicated with the system controller previously; and

identifying a downstream plant associated with the upstream plant that transmits said first message from said set-top terminal;

wherein a location of said set-top terminal within said system comprises an identification of said upstream plant and said associated downstream plant.

(emphasis added)

Similar subject matter is recited in independent claims 11 and 20.

In contrast, Caporizzo does not teach or suggest a *system controller* that “automatically determin[es] which upstream plant of a plurality of upstream plants transmits a first message to said system controller from a particular set-top terminal that has not communicated with the system controller previously.”

According to the final Office Action, “Caporizzo teaches a first message containing 217784 received at the headend. The headend (claimed system controller) automatically determines which upstream plant of a plurality of upstream plants transmits the message by deciphering the message, in this case the 2 is the trunk number, 1 is the line extender, and 7784 is the set top serial number.” (Paper No. 8, p. 2). This is a significant misstatement of what Caporizzo actually teaches.

*Caporizzo does not teach or suggest that the identification number 217784 is received at the headend in a first message from a previously unlocated set-top terminal as suggested in the final Office Action.* Rather, Caporizzo states that “*the headend 15 includes a database of the entire CATV network topology. As part of the cable system customer database each subscriber is identified by specifying a specific address.* For example, a settop terminal 10 located on cable system trunk number 2, line extender 1, with settop Ser. number 7784 will have a terminal identification number of 217784.” (Col. 6, lines 5-10) (emphasis added). The headend then uses the addresses already in the database to communicate *downstream* (i.e., to poll) specific set-top terminals. (Col. 6, line 10).

Thus, Caporizzo teaches a database *already at the headend* which includes addresses that specify a *downstream* path for each set-top terminal. These addresses are apparently not created by the headend, but are provided to the headend as set-top terminals are manually

added to the system. These addresses specify a downstream path to a set-top terminal and do not represent or designate an upstream plant for each set-top terminal.

Consequently, Caporizzo does not teach or suggest that the headend or "system controller" "automatically determine[es] which upstream plant from a plurality of upstream plants transmits a first message to said system controller from a particular set-top terminal that has not communicated with the system controller previously."

Moreover, Caporizzo does not teach or suggest that, once the upstream plant has been automatically identified, the method proceeds by "identifying a downstream plant associated with the upstream plant that transmits said first message from said set-top terminal." The downstream plant for each set-top terminal is already recorded in the headend database taught by Caporizzo.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, because Caporizzo fails to teach or suggest any of the features of independent claims 1, 11 and 20, the rejection of claims 1-27 should be reconsidered and withdrawn.

Similarly, new claims 37-43 are thought to be patentable over the prior art of record based again on Caporizzo's failure to teach a registration or location process that is initiated by the set-top terminal.

Claim 28 recites:

A method of adding a set-top terminal to a cable television system, said method comprising:

selling a set-top terminal through a retail distribution model in which a subscriber purchases the terminal at a retail outlet and installs the terminal;

connecting said set-top terminal to said cable television system without advance notice to operators of said cable television system;

with a system controller, automatically determining which upstream plant of a plurality of upstream plants transmits a first message to said system controller from a particular set-top terminal; and

identifying a downstream plant associated with the upstream plant that transmits said first message from said set-top terminal;

wherein a location of said set-top terminal within said system comprises an identification of said upstream plant and said associated downstream plant.

(emphasis added).

Support for amended claim 28 can be found in Applicant's specification at page 4, lines 13 and 14.

In contrast, Caporizzo fails to teach or suggest selling a set-top terminal through a retail distribution model and "connecting said set-top terminal to said cable television system without advance notice to operators of said cable television system," where the system then automatically locates the terminal within the system to establish two-way communication with the terminal. Similar subject matter is also recited in claims 23, 25 and 26.

The final Office Action acknowledges that Caporizzo fails to teach or suggest these features of the claimed invention. (Paper No. 8, p. 8). However, the Office Action then alleges that the features of claims 23, 25, 26 and 28 are obvious over Caporizzo taken alone. This is clearly insufficient.

The examiner has the burden of demonstrating that all the claimed features of the invention are taught by the prior art. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Where the examiner relies on a single reference under § 103, it is insufficient to merely state

that it would be obvious, or a mere matter of design choice, to modify the disclosure to include the features of the claimed invention. *In re Mills*, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. (emphasis added). *Accord.* M.P.E.P. § 706.02(j).

"The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. *In re Ahlert*, 424 F. 2d 1088, 165 USPQ 418, 420 (CCPA 1970). . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." M.P.E.P. § 2144.03. Accordingly, Applicant hereby traverses the rejection of claims 23, 25, 26 and 28 and requests that references be cited which teach selling a set-top terminal, connecting the terminal to the cable system without advance notice to the operator's of the system and the subsequent location and integration of the set-top terminal into the system as claimed.

Claims 25 and 28-36 were rejected under 35 U.S.C. § 112, first paragraph, as lacking written description in the application as originally filed. However, in the Advisory Action of December 22, 2003 (Paper No. 10), this rejection was withdrawn.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to

Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



Steven L. Nichols  
Registration No. 40,326

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Steven L. Nichols, Esq.  
Managing Partner, Utah Office  
**Rader Fishman & Grauer PLLC**  
River Park Corporate Center One  
10653 S. River Front Parkway, Suite 150  
South Jordan, Utah 84095

(801) 572-8066  
(801) 572-7666 (fax)